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MARSHALL, GERSTEIN & BORUN LLP
233 S. Wacker Drive, Suite 6300
Sears Tower
Chicago, IL 60606

In re Application of
VILLARI *et al*
U.S. Application No.: 10/527,385
PCT No.: PCT/EP2003/010097
Int. Filing Date: 11 September 2003
Priority Date: 13 September 2002
Attorney Docket No.: 30882/SCG5204
For: FIREPROOF GLAZING UNIT

DECISION

This decision is in response to a Petitioner's petition under 37 CFR 1.47(a) filed with the United States Designated/Elected Office (DO/EO/US) on 29 August 2005.

BACKGROUND

On 11 August 2005, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that the current declaration under PCT Rule 4.17 was not in compliance with 37 CFR 1.497(a) and (b). Applicants were given two months to respond with extensions of time available.

On 29 August 2005, applicants filed a response which was accompanied by, *inter alia*, a petition under 37 CFR 1.47(a); a \$130.00 petition fee; a \$130.00 surcharge fee; a declaration by Valentino Villari; a declaration by Christine Davids; and copies of internet searches, postal receipts and correspondence.

DISCUSSION

In response to the Form PCT/DO/EO/905, applicants submitted a petition under 37 CFR 1.47(a) claiming that the nonsigning inventor was refusing to cooperate, or unable to be located.

A petition under 37 CFR 1.47(a) must be accompanied by: (1) the required petition fee; (2) factual proof that the missing joint inventor(s) cannot be located or refuses to cooperate; (3) a statement of the last known address(es) of the nonsigning joint inventor; (4) and an oath or declaration executed by the signing joint inventor(s) on their behalf and on behalf of the nonsigning joint inventor.

- Concerning item (1), the fee for a petition under 37 CFR 1.47 has changed to

\$200.00. Applicants submitted a \$130.00 petition fee. The additional fee of \$70.00 has been charged to Deposit Account No. 13-2855 as authorized.

With regards to item (3), the last known address of the nonsigning joint inventor, Albert van Oijen, is listed as:

De Burkel 3
NL-5851 CC Afferden
The Netherlands

Regarding item (2), the 37 CFR 1.47(a) applicants claim that Mr. Oijen refuses to cooperate, or in the alternative cannot be located.

Refusal to Cooperate

Section 409.03(d) of the MPEP states, in part:

A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers.

In her declaration, Ms. Davids states that a complete copy of the application was submitted to the nonsigning inventor on 04 April 2005 at his last known address. However, the documents were not claimed by Mr. Oijen. Further, there was no evidence that he refused to accept delivery. Thus, a refusal cannot be shown without evidence that the nonsigning inventor has been presented with a complete copy of the application, or that he refused to accept delivery of the application.

It is also noted that the documentary evidence provided with the petition is in a foreign language without accompanying English translations. The Office does not accept foreign language documents as evidence without a corresponding English translation. Further, the EPO priority document referenced in the declaration of Mr. Villari is not sufficient to meet the requirement of the MPEP.

Cannot Be Located

Applicants' burden in showing that an inventor cannot be located is explained in section 409.03(d) of the MPEP which states, in part:

Where inability to find or reach a nonsigning inventor 'after diligent effort'

is the reason for filing under 37 CFR 1.47, an affidavit or declaration of the facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made . . .

The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement. The steps taken to locate the whereabouts of the nonsigning inventor should be included in the statement of facts. It is important that the statement contain facts as opposed to conclusions.

In this case, counsel has outlined the steps taken to locate the nonsigning inventor in the petition. But it is not clear if counsel has the requisite firsthand knowledge required by the MPEP. Moreover, the documentary evidence submitted is also in a foreign language without an accompanying English translation. Petitioner must provide a translation of the results of these searches. Petitioner must also identify who performed these searches for the nonsigning inventor and provide a declaration of this person, if possible.

Concerning item (4), section 409.03(a) of the MPEP requires all available joint inventors to file an application "on behalf of" themselves and on behalf of a joint inventor who "cannot be found or reached after diligent effort" or who refuses to "join in an application."

Here, a declaration signed by one of the two joint inventors pursuant to PCT Rule 4.17 was submitted in the international application. However, this declaration was filed on 12 December 2003 pursuant to PCT Rule 26ter. As such, the declaration must be directed to the international application. There is no evidence that the declaration complied with this requirement.

For these reasons, item (2) and (4) of 37 CFR 1.47(a) are not yet satisfied.

CONCLUSION

Applicants' petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. No additional petition fee is required.

Any further correspondence with respect to this matter deposited with the United States Postal Service should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

A handwritten signature in cursive script that reads "James Thomson".

James Thomson
Attorney Advisor
Office of PCT Legal Administration

Tel.: (571) 272-3302